UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EUGENE J. ROLLINS,
SAILENDRA PADALA,
and NORBERT HENDRIKSE

Appeal 2007-0286
Application 09/747,656
Technology Center 3600

Decided: December 14, 2007

Before TERRY J. OWENS, MURRIEL E. CRAWFORD, and JENNIFER D. BAHR, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellants appeal from a rejection of claims 1-6 and 9-14. Claims 7, 8, and 15-17 stand withdrawn from consideration by the Examiner.

THE INVENTION

The Appellants claim a method and computer-readable medium for processing requests for electronic documents. Claim 1 is illustrative:

> 1. A method for processing requests for electronic documents, the method comprising the computer-implemented steps of:
>
> receiving a first request for a first electronic document, wherein the first electronic documents is associated with a first address;
>
> providing the first electronic document;
>
> receiving, by an intermediary, a second request for a second electronic document based upon selection of a first object that is included in the first electronic document, wherein the first object is associated with a second address of the second electronic document;
>
> retrieving the second electronic document;
>
> generating, by the intermediary, an updated second electronic document that includes a second object associated with the first address; and
>
> providing the updated second electronic document in response to the second request for the second electronic document.

THE REFERENCE

Arnold	6,016,504	Jan. 18, 2000

THE REJECTION

Claims 1-6 and 9-14 stand rejected under 35 U.S.C. § 102(e) as anticipated by Arnold.

OPINION

We reverse the Examiner's rejection. We need to address only the independent claims, i.e., claims 1 and 9. Claim 1 requires the method step of "generating, by the intermediary, an updated second electronic document that includes a second object associated with the first address". Claim 9 requires a computer-readable medium carrying instructions that cause the step of "generating, by the intermediary, an updated second electronic document that includes a second object associated with the first address".

For a claimed invention to be anticipated under 35 U.S.C. § 102(b), all of the elements of the claim must be found in one reference. *See Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991).

Arnold discloses "a method and system for tracking sales on the Internet" (col. 1, l. 9). A virtual outlet (VO) owner signs up to offer a merchant's products for sale through the VO's Web page (col. 5, ll. 27-30). To start the purchase process a customer views the VO's Web page and selects the desired product's image (col. 5, ll. 46-49). That image has a URL associated with it that is a hotlink to a merchant's Web page and includes a unique identification of the VO (col. 5, ll. 44-46, 63-65). The merchant computer can use that unique identification to store a return URL that identifies the VO's Web page so that, upon completion of the order, the merchant's computer can direct the customer's computer to the VO Web page identified by the return URL (col. 6, ll. 1-6). Alternatively, the return URL can be supplied by the VO as part of the URL of the hotlink within the VO Web

page that displays the product's image to the customer (col. 6, ll. 6-12). When the merchant computer receives the hotlink URL containing the VO's return URL, the merchant's computer accesses a database that was established when the VO signed up to sell the merchant's products (col. 7, ll. 54-58). That database specifies a Web page layout that preferably is similar to the VO's Web page layout "(col. 7, ll. 58-62). "The merchant computer then dynamically creates a Web page (e.g., an HTML file) in accordance with the layout and associates the return URL with an icon [return button, fig. 1B item 1B30] on the Web page" (col. 7, ll. 62-65). After the customer has completed the purchase using that Web page the customer can select the return icon to return to the VO's Web page (col. 8, ll. 4-6).

The Examiner argues that Arnold's VO corresponds to the Appellants' intermediary and that Arnold's Web page dynamically created by the merchant computer in accordance with the VO's Web page layout corresponds to the Appellants' updated second electronic document (Ans. 6). The Examiner argues (Ans. 6-7):

> Arnold discloses the second electronic document being generated and displayed to the customer (see Fig. 1B (1B30-"ACME Cyberstore")), and further discloses the virtual outlet passing to the second electronic document a URL address (col. 6, lines 6-12) used in the generation and updating of the second electronic document (please note: both the virtual outlet and the selected online merchant contribute to the generation of the second document). The virtual outlet provides to the second electronic document a URL address associated with the first electronic document that is specifically associated

> with an icon on the second electronic document (please see Fig. 1B (1B20-"ACME Cyberstore", 1B30-ACME Cyberstore", "RETURN" icon[)]; col. 8, lines 4-6) (please note: the RETRUN [sic] icon links the consumer to the virtual outlet that directed the consumer to the merchant site which provides more functionality than the standard "BACK" button on a web browser).

The Appellants' independent claims do not require mere contribution by the intermediary to the generation of the updated second electronic but, rather, require that the updated second electronic document is generated by the intermediary. Thus, the Examiner's argument that "both the virtual outlet and the selected online merchant contribute to the generation of the second document" (Ans. 7) is not persuasive. Although the URL of the return button on Arnold's Web page dynamically created by the merchant is provided by the VO, it is the merchant's computer, not the VO, that generates the dynamically created Web page containing a return icon to the VO's Web page (col. 7, l. 62 – col. 8, l. 6).

The Examiner, therefore, has not established a prima facie case of anticipation of the Appellants' claimed invention by Arnold.

DECISION

The rejection of claims 1-6 and 9-14 under 35 U.S.C. § 102(e) over Arnold is reversed.

REVERSED

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